

**BIRCH, STEWART, KOLASCH & BIRCH, LLP**

INTELLECTUAL PROPERTY LAW  
8110 GATEHOUSE ROAD  
SUITE 500 EAST  
FALLS CHURCH, VA 22042-1210  
USA

(703) 205-8000

FAX: (703) 205-8050  
(703) 698-8590 (G IV)

e-mail: mailroom@bskb.com  
web: http://www.bskb.com

CALIFORNIA OFFICE  
COSTA MESA, CALIFORNIA

SCOTT L. LOWE  
PAUL C. LEWIS  
RICHARD J. GALLAGHER  
JAYNE M. SAYDAH\*  
MARYANNE ARMSTRONG, PH.D.  
KECIA J. REYNOLDS  
ROBERT L. SCOTT, II  
KALPANA REDDY  
MARK E. OLDS  
ESTHER H. CHONG  
CATHERINE M. VOISINET\*  
EUGENE T. PEREZ

REG. PATENT AGENTS:  
FREDERICK R. HANDREN  
MAKI HATSUMI  
CRAIG A. McROBBIE  
GARTH M. DAHLEN, PH.D.  
ROBERT E. GOOZNER, PH.D.  
KRISTI L. RUPERT, PH.D.  
MATTHEW T. SHANLEY  
SUSAN W. GORMAN, PH.D.  
DAVID J. CHO  
ROBERT W. DOWNS

TERRELL C. BIRCH  
RAYMOND C. STEWART  
JOSEPH A. KOLASCH  
JAMES M. SLATTERY  
BERNARD L. SWEENEY\*  
MICHAEL K. MUTTER  
CHARLES GORENSTEIN  
GERALD M. MURPHY, JR.  
LEONARD R. SVENSSON  
ANDREW D. MEIKLE  
MARC S. WEINER  
JOE MCKINNEY MUNCY  
ROBERT J. KENNEY  
JOHN W. BAILEY  
MARK J. NUELLE, PH.D.  
JAMES T. ELLER, JR.  
D. RICHARD ANDERSON

OF COUNSEL:  
HERBERT M. BIRCH (1905-1996)  
ELLIOT A. GOLDBERG\*  
WILLIAM L. GATES\*  
EDWARD H. VALANCE  
RUPERT J. BRADY (RET.)\*  
F. PRINCE BUTLER  
FRED S. WHISENHUNT  
JAMES W. HELLWEGE

\*ADMITTED TO A BAR OTHER THAN VA

Date: January 29, 2002

Docket No.: 1403-0223P

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

This is a Request for filing a continuation application under 37 C.F.R. § 1.53(b) of pending prior Application No. 08/110,836 filed on August 24, 1993, the entire contents of which are hereby incorporated by reference, by

Takafumi TAGUCHI; Mamoru UCHIDA; Kiyoshige MURAOKA

for

PNEUMATIC TIRE

1. ☒ Enclosed is an application consisting of specification, claims, declaration and drawings/photographs (if applicable).
2. ☒ The filing fee has been calculated as follows:

			LARGE ENTITY	SMALL ENTITY
BASIC FEE			\$740.00	\$370.00
	NUMBER FILED	NUMBER EXTRA	RATE FEE	RATE FEE
TOTAL CLAIMS	7-20 =	0	X 18 = \$0.00	x 9 = \$0.00
INDEPENDENT CLAIMS	2-3 =	0	X 84 = \$0.00	x 42 = \$0.00
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS PRESENTED			+ \$280.00	+ \$140.00
		TOTAL	\$740.00	\$0.00

3. ☒ A check in the amount of \$740.00 to cover the filing fee and recording fee (if applicable) is enclosed.
4. ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this request is enclosed.
5. Amend the specification by inserting before the first line thereof the following:
- a. ☐ --This application is a continuation of co-pending Application No. 08/110,836, filed on August 24, 1993, which is a continuation of 07/735,062, filed on July 24, 1991, which is a continuation-in-part of 07/486,604 which was filed on February 28, 1990 the entire contents of which are hereby incorporated by reference and for which priority is claimed under 35 U.S.C. § 120; and this application claims priority of Application No. 51764/1989 filed in Japan on March 2, 1989 under 35 U.S.C. § 119.--
- b. ☐ --This application is a ☐ continuation ☐ divisional ☐ continuation-in-part of co-pending Application No. \_\_\_\_\_, filed on \_\_\_\_\_ and for which priority is claimed under 35 U.S.C. § 120. Application No. \_\_\_\_\_ is the national phase of PCT International Application No. PCT/\_\_\_\_\_/\_\_\_\_\_ filed on \_\_\_\_\_ under 35 U.S.C. § 371. The entire contents of each of the above-identified applications are hereby incorporated by reference. This application also claims priority of Application No. \_\_\_\_\_ filed in \_\_\_\_\_ on \_\_\_\_\_ under 35 U.S.C. § 119.--

6. ☒ Enclosed is/are five (5) sheet(s) of formal drawings and/or photographs.
- 7a. ☐ A statement claiming small entity status was filed in prior Application No. \_\_\_\_\_ on \_\_\_\_\_. See the attached copy of the statement claiming small entity status.
- 7b. ☐ The current application qualifies for small entity status.
8. ☒ The prior application is assigned to Sumitomo Rubber Industries, Ltd..
9. ☐ A Preliminary Amendment is enclosed.
- 10a. ☒ Priority of Application No(s). 51764/1989 filed in Japan on March 2, 1989 is/are claimed under 35 U.S.C. § 119. See attached copy of the Letter claiming priority filed in the prior application on June 7, 1990.
- 10b. ☐ Priority of International Appln. \_\_\_\_\_ filed on \_\_\_\_\_ under the Patent Cooperation Treaty and Application No. \_\_\_\_\_ filed in \_\_\_\_\_ on \_\_\_\_\_ under 35 U.S.C. § 119 are hereby reclaimed.
11. ☒ An Information Disclosure Statement and PTO-1449 form(s) are attached hereto for the Examiner's consideration.
12. ☒ Address all future communications to:  
  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
P.O. Box 747  
Falls Church, VA 22040-0747  
Telephone: (703) 205-8000  
  
or  
Customer No. 2292
13. ☐ An extension of time for \_\_\_\_\_ ( ) month(s) until \_\_\_\_\_ has been submitted in parent Application No. \_\_\_\_\_ in order to establish co-pendency with the present application.
14. ☒ Also enclosed herewith is the following:  
  
PETITION UNDER 37 CFR 1.103(a) TO SUSPEND ACTION  
  
\$130.00 Fee for the Petition

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP


By 

Andrew D. Meikle, #32,868

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

  
JAK/ADM/GMD/jeb  
1403-0223P

Attachments

(Rev. 11/15/01)

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: TAGUCHI et al. Conf.: Unknown  
Appl. No.: NEW Group: Unknown  
Filed: January 29, 2002 Examiner: Unknown  
For: PNEUMATIC TIRE

PETITION UNDER 37 C.F.R. §1.103(a) FOR SUSPENSION OF ACTION

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

Applicants herein request that action in the above-identified application be delayed under the provisions of 37 C.F.R. §1.103(a).

Period of Request

Applicants respectfully request that action be suspended for a period of **six (6)** months until July 29, 2002.

Good and Sufficient Reasons Why Suspension is Necessary

This application is a continuation application of U.S. Serial No. 08/110,836 (hereinafter US '836), filed August 24, 1993. During prosecution of U.S. '836 the Examiner rejected claims under 35 USC 103 based on the combination of Koch et al., USP 3,038,515 in view of Exxon ("Bromobutyl Rubber..." 1986, pages 7, 8, 53 and 54), Gessler et al., USP 4,014,852, and optionally Hous, GB 2,072,576. Also, the claims were rejected under 35 USC

103 based on the combination of Koch et al. in view of Berta, USP 4,616,686 and Berta, USP 4,587,302. During prosecution of US '836, Applicants relied, in part, on experimental evidence to patentably distinguish the presently claimed invention over the cited references. However, the Examiner maintained the final rejection and the Examiner's rejections were appealed to the Board of Patent Appeals and Interferences. On November 29, 2001, the Board affirmed the Examiner's rejections citing several deficiencies in Applicants' experimental evidence to overcome the *prima facie* case of obviousness.

Accordingly, Applicants herein request that action be suspended for a period of six (6) months to give Applicants time to prepare and run further tests to overcome the deficiencies identified by the Board and the Examiner.

Since an object of the presently claimed tire is to have improved wear and corrosion resistant characteristics, experiments which test these characteristics generally take a long period of time. Thus, there is good and sufficient reasons why the suspension of six (6) months is necessary.

The petition fee as set forth in 37 C.F.R. §1.17(h) is attached hereto.

This petition is submitted on behalf of the

Docket No. 1403-0223P

Assignee/Applicants by the undersigned, an attorney of record in the above-identified application.

Please charge any necessary fees or credit any overpayment pursuant to Deposit Account No. 02-2448.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

1/29/02

Date

JAK/ADM/GMD/jeb  
1403-0223P

By

Joseph A. Kolasch, #22,463

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000